REMARKS

This is a full and timely response to the outstanding nonfinal Office Action mailed August 26, 2003. Claims 1, 2, 4-12, 14-22, and 24-30 are pending in the application. Applicants have amended claims 1, 2, 4, 11, 12, 14, 16–22, 24, and 26. No new matter has been added. Claims 3, 13, and 23 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims are respectfully requested.

I.   Claims 1 – 30 are Patentable Over U.S. Patent No 5,075,787

The Office Action rejects claims 1-30 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,075,787 to Shaughnessy *et al.* ("the '787 patent") or U.S. Patent No. 5,138,465 to Ng *et al.* ("the '465 patent"). Applicants respectfully submit that this rejection should be withdrawn for at least the reason that both the '787 patent and the '465 patent fail to disclose, teach, or suggest all of the limitations/features/elements of the claims. Accordingly, Applicants respectfully request that the rejection be withdrawn and claims 1 – 30 be allowed.

In this regard, Applicants note that independent claims 1, 11, and 21 include limitations/features/elements that are not disclosed, taught, or suggested by either the '787 patent or the '465 patent. Specifically, independent claims 1, 11, and 21 recite the limitations/features/elements of detecting handwriting in a scanned image and saving the detected handwriting as an annotation in a document generated from the scanned image. Independent claim 1 is directed to a system and claim 1 recites "automatic annotation logic configured to detect handwriting in a scanned image and save said handwriting as an annotation in a document generated from said scanned image." Independent claim 11 is

directed to a method and claim 11 recites "detecting handwriting in said scanned image and saving said handwriting as an annotation in a document generated from said scanned image." Independent claim 21 is directed to a computer readable medium having a program and claim 21 recites "logic for detecting handwriting in said scanned image and saving said handwriting as annotation in a document generated from said scanned image."

Applicants respectfully submit that neither the '787 patent nor the '465 patent disclose, teach, or suggest the limitations/features/elements of detecting handwriting in a scanned image and saving the handwriting as an annotation. Rather, both the '787 patent and the '465 patent merely disclose a copier capable of making a "selectively edited reproduction" of an original document sheet based on markings placed on the original sheet by a user with a highlighting marking pen. The systems disclosed in the '787 patent and the '465 patent require the user to place highlighting markings (*e.g.*, bounding loops, character codes) on the original document. The highlighting markings are placed on the original document by the user to specify the areas in the document to be processed by one or more treatment modes (*e.g.*, color-accenting). *See* Fig. 3, the '465 patent; Fig. 3a, the '787 patent.

The systems disclosed in the '787 patent and the '465 patent do not detect the handwriting to be saved. Rather, these systems merely detect the character code or highlighted marks. Furthermore, these systems do not save the detected text (*i.e.*, character code, highlighting marks). Instead, the detected text is used to signal to a processor a particular treatment mode for determining the manner in which some other text is to be edited (*e.g.*, deleted, repositioned, tinted). The '787 patent and the '465 patent do not disclose, teach, or suggest detecting the handwriting and saving the handwriting as an annotation.

For at least this reason, Applicants respectfully assert that independent claims 1, 11, and 21 are patentable over the '787 patent and the '465 patent. Dependent claims 2 and 4 -

10 (which depend from independent claim 1), dependent claims 12 and 14 – 20 (which

depend from independent claim 11), and dependent claims 22 and 24 – 30 (which depend

from independent claim 21) are also patentable over the '787 patent and the '465 patent for at

least the reason that they contain all of the limitations/features/elements of the corresponding

independent claim. Accordingly, Applicants respectfully request that the rejection of claims 1

– 30 be withdrawn and pending claims 1, 2, 4-12, 14-22, and 24-30 be allowed.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above,

Applicant respectfully submits that all objections and/or rejections have been traversed,

rendered moot, and/or accommodated, and that pending claims 1, 2, 4-12, 14-22, and 24-30

are in condition for allowance. Favorable reconsideration and allowance of the present

application and all pending claims are hereby courteously requested. If, in the opinion of the

Examiner, a telephonic conference would expedite the examination of this matter, the Examiner

is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

Adam E. Crall, Reg. No. 46,646

THOMAS, KAYDEN,
 HORSTEMEYER & RISLEY, L.L.P.
100 Galleria Parkway N.W., Suite 1750
Atlanta, Georgia 30339
(770) 933-9500

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